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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 21

ABC MANUFACTURING CO., INC., ET AL., *Petitioners*,

v.

CONVERTIBLE TOP REPLACEMENT CO., INC., *Respondent*.

RESPONDENT'S REPLY TO THE MEMORANDUM OF THE UNITED STATES AS AMICUS CURIAE

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No. 582

ABO MANUFACTURING CO., INC., ET AL., *Petitioners*,

v.

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RESPONDENT'S REPLY TO THE MEMORANDUM OF THE UNITED STATES AS AMICUS CURIAE

PRELIMINARY STATEMENT

This is a run-of-the-mill patent case.

1. The patent was found valid by the District Court—"Mackie-Duluk was a substantial and enlightened step, filling a long-felt want," (JA 34)—and, on appeal, "the question of validity has hardly been argued at all" (Pet. 24). Accordingly, said the Court of Appeals (Pet. 24-25), "Under these circumstances we can only take the validity of the patent claims in suit for granted and turn immediately to the *hotly contested* issue of infringement" (Italics added).

2. On that issue, the principal defense was that of repair. The District Court (Aldrich, J.) made numerous specific findings of fact adverse to petitioners on that defense; and said (JA 39), "Whether the test be that of substantial reconstruction, or domination of the part replaced, or frequency of replacement, I find that replacing the fabric is not permissive repair."

The Court of Appeals, applying and discussing the rule of *Wilson* v. *Simpson*, 9 How. 109, and of *Heyer* v. *Duplicator Mfg. Co.*, 263 U.S. 100, held that the terms of 35 U.S.C. § 271(c) "could [not] have been intended to prevent the rightful owner of a patented machine from making repairs to a broken, worn, or defective part, even though covered by the patent, either himself or through someone other than the patentee"; nor did the Court of Appeals read the statute "to prevent the owner of a patented machine from replacing from a source other than the patentee minor patented parts of a combination which in the normal use of the machine may be expected frequently to wear out or break and hence to require replacement at short intervals to keep the whole machine in working order and condition" (Pet. 29).

Then, after stating (Pet. 31) that instances wherein replacement of a component "constitutes a forbidden reconstruction of the combination of which it forms a part is difficult to determine and cannot be determined by the application of any verbal formula," and that (*ibid.*) "Each case must be decided on its own facts, pretty much as an individual instance," the Court of Appeals concluded (Pet. 32) that "the defendants were not making permissible repairs to, but were substantially reconstructing, the convertible top combination covered by the Mackie-Duluk patent."

3. Judge Aldrich said (JA 33, note 1), "Finally, they [the defendants, petitioners here] claim mis-use of the patent, a defense I find clearly not made out."

In the Court of Appeals, petitioners argued (Br. for Defendants, Appellants, 51, *et seq.*), "The Plaintiff Is Trying to Control the Sale of Unpatentable Fabric Tops," and cited, *inter alia*, *Carbice Corp.* v. *American Patents Corp.*, 283 U.S. 27, and *Mercoid Corp.* v. *Mid-Continent Co.*, 320 U.S. 661.

This argument evoked from the Court of Appeals only the comment (Pet. 33) that "other arguments advanced by the appellants have been considered but are rejected as too insubstantial to call for discussion."

4. What, then, does this case present that should call for intervention by the Government? We assume that the United States is not somehow *parens patriae* for adjudicated infringers, least of all in a case where infringement is as crass as that disclosed by the present record. Examination of the Government's memorandum shows that its arguments are based on premises that are either not substantiated or else contradicted by the record. Moreover, the record shows that the present case turns on an evaluation of complicated factual data, and that both courts below correctly applied to such data the unquestioned criteria heretofore announced by this Court, of which perhaps the controlling one, in the words of Mr. Justice Holmes in *Heyer* v. *Duplicator Mfg. Co.*, 263 U.S. 100, 102, was "common sense applied to the specific facts." Since it is not the function of this Court to formulate mere dicta, this case is plainly not one that justifies further review.

I. ESTABLISHED CRITERIA OF REVIEW ON CERTIORARI DEMONSTRATE THE LACK OF PUBLIC IMPORTANCE IN THE PRESENT CASE

While the Government says (U.S. Memo. 2) that the articles in question involve a sizable industry, relying on Judge Aldrich's original finding to that effect (JA 34), later proceedings reflected in the record cast doubt on that conclusion. The petitioner Shapiro, while on the witness stand prior to the original finding, exaggerated the quantity of infringing manufacture threefold in a desperate effort to make this case appear important. During a *later* inquiry into damages Shapiro filed an affidavit denying the truth of his testimony on the stand. Judge Aldrich thereafter found: (JA 46)

> "I find it difficult to believe that Shapiro's testimony on the stand was not reckless, or worse."

The top fabrics here involved were designed primarily for certain automobiles of 1954, and earlier, models (JA 33), cars which are now rapidly disappearing from the streets. The trial court found that the "percentage [of infringing tops sold] decreases as time progresses" (JA 46). At the present time, these tops are of little importance economically. Indeed, petitioner Aro, "the national leader," no longer makes *any* of these tops, and has adopted and sells an entirely different and clearly non-infringing fabric shape for use on the few 1954 and earlier cars still on the streets (Acct. Tr. 186, 187 516).[1]

Nor is the decision below shown to have any major economic effect on other industries. While the Gov-

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[1] The reference to "Acct. Tr." is to testimony taken during the subsequent accounting phase of the present litigation, and appended hereto as Appendix 1.

ernment asserts (U.S. Memo. 4) that the issue is "a constantly recurring question," litigation involving the question of "permissible repair" is in fact very infrequent. The Government's assertion, if intended to mean (as its statement seems to import) that the issue is a "constantly recurring question" in the courts, is simply not so. Thus, in the last ten years,[2] between *Williams* v. *Hughes Tool Co.*, 186 F. 2d 278 (C.A. 10), certiorari denied, 341 U.S. 403, and the present litigation, there has been only a single reported case on the question (and mentioned there only in passing); and that one case involved a very different factual situation, viz., the re-tipping of worn oil well drill bits. *Hughes Tool Co.* v. *Cole*, 113 F. Supp. 519, 525 (D.C. Okl., 1953).

Interestingly enough, in *Williams* v. *Hughes Tool Co., supra*, the Government also filed a Memorandum *Amicus Curiae* in support of the Petition for Certiorari, and presented arguments very similar to those it now puts forward here. In the earlier case, the Government conceded (U.S. Memo., No. 561 Oct. T. 1950, p. 6) that:

> "* * * whether a particular repair on a particular patented combination is of such major character as to constitute a reconstruction of the combination would not, ordinarily, it may be assumed, be regarded as a question warranting review by this Court."

It is submitted that this is still the case here. Indeed, the quoted statement amounts to an admission that, as a general rule and in a proper factual situation, there

[2] See digests of the United States Patent Quarterly (Key 39.70 "Infringement—Repair and Reconstruction"); and the Federal Digest (Key 255 "Making, Repair of, or Substitute for Patented Article").

may be a reconstruction even though not all parts of a combination are replaced; and this Court has indeed so held. *Cotton Tie Co.* v. *Simmons*, 106 U.S. 89.

In its prior memorandum (p. 7) as well as in its present one (p. 10), the Government sought to limit that general rule, without regard to any other factual considerations, to the situation where one part of a combination has a shorter life than any other part.

The circumstance that review was denied in *Williams* v. *Hughes Tool Co.* fairly indicates that this Court then considered the suggested distinction insufficient to warrant further review. The paucity of similar cases since that action confirms the relative unimportance of the issue. And in the infrequent instances when the question does arise, the facts are so different and distinct from what has gone before that no one decision ever has significant precedential value for the future.

Although the District Court's opinion (119 U.S. P.Q. 122) was published over fifteen months ago, and that of the Court of Appeals (270 F. 2d 200; 122 U.S.P.Q. 536) over five months ago, there has been, insofar as respondent is aware, no published professional comment on either decision. Indeed, the Department of Justice did not even hear of the rulings until recently; and the Solicitor General advised the Clerk of this Court on January 14, 1960, that the case came to his attention only "yesterday." It will therefore hardly be a surprise to the Court that the Department was advised of the rulings in question only at the instance of petitioners' counsel.

In short, any statements concerning the alleged importance of the present case can mean little more than that its determination is important to the petitioners.

II. THE COURT BELOW WAS CLEARLY RIGHT IN HOLDING THAT "EACH CASE MUST BE DECIDED ON ITS OWN FACTS, PRETTY MUCH AS AN INDIVIDUAL INSTANCE"

When this case was before the court below, petitioners strongly urged the Holmes "common sense" test (*Heyer* v. *Duplicator Mfg. Co., loc. cit. supra*), and further urged that each case should be decided on its own facts. Respondent entirely agrees. We attach hereto, as Appendix 2, a chapter of petitioners' Court of Appeals brief, from which it is plain that the question of reconstruction versus repair is one of ultimate fact. The sole controversy between the parties has always comprised no more than one of fact.

Respondent's brief before the Court of Appeals discussed, at pp. 26-31, eight different factual considerations, established by the specific facts of record here, which compelled the factual conclusion reached by both courts below that petitioners truly reconstructed the patented invention. Petitioners' brief before the Court of Appeals, pp. 25-47, discussed seven other factual considerations appearing in the record and bearing on that question (see Appendix 2). These fifteen factual points, and the proofs of record in regard to each, are often in direct conflict. The Court of Appeals resolved these fifteen factual controversies, and then decided the case (Pet. 31) "on its own facts, pretty much as an individual instance", in favor of reconstruction.

Consequently, review here could not rise above still another analysis of the fifteen factual considerations urged by the parties below.

III. THE GOVERNMENT'S MEMORANDUM RESTS UPON UNSUPPORTED AND ERRONEOUS ASSUMPTIONS OF FACT

Not only is the essential issue in the present case factual, but the Government's effort to inflate this litigation into one that raises the particular question which is said (U.S. Memo. 2-3) to be of public concern rests on assumptions that are demonstrably without record support.

The Government's argument (U.S. Memo. 9), that "There can be no contributory infringement in the absence of direct infringement," has no application here, as it necessarily assumes that there was no direct infringement. The contrary is however the fact.

Here, as is customary in patent litigation, the purpose of the trial was to determine whether there had been any infringement at all. In order to establish a *prima facie* instance of infringement, respondent proved that from 1952 through 1954, Ford Motor Co. sold Ford convertibles without any license whatsoever. In 1954 and thereafter, petitioners sold and actually installed on Ford cars, specially shaped replacement tops; and the resulting structure met each and every element of the claims in suit (JA 128 et seq.). Two such cars were demonstrated to the District Judge, who found infringement (J.A. 33, 41). There was at that time no license from the patentee to Ford, to the car owners, or to petitioners; and the District Judge specifically found (JA 38) that [Ford] cars manufactured with Mackie-Duluk tops were unlicensed. It would be difficult to imagine a clearer case of direct infringement.

Indeed, even as to the particular G.M. cars here involved, petitioners' own installation procedures, in

own trim shop, clearly amounted to actual recon-
ion of the patented invention; wherefore direct
gement was again established.

third question presented by the Petition (Pet.
restated by the Government (U.S. Memo. 3),[3] is
eated upon numerous additional erroneous as-
tions of fact.

r example, the Government's restated question as-
s that the Mackie-Duluk type fabric "has a sub-
ially shorter life cycle than the machine's other
onents." However, while the wiper arm, being
ructed of metal, would normally last the life of the
it is actually so mounted that in "one out of ten"
fteen" General Motors cars, the wiper arm falls
efore the top fabric is replaced (Tr. 402).[4] This
l part, although per se undamaged, therefore
ly has a shorter *practical* life than the fabric top.
ed the record shows that a top fabric may well last
or five years (JA 205), and the life of the trough
ften about the same (Tr. 406).

he restated question also assumes incorrectly that
Mackie-Duluk type fabric "*must* be replaced"; and
error is repeated at U.S. Memo. 7, where the Gov-
ment states that replacement with the particular
ric here involved "is necessary" etc. Petitioners

[3] "... whether the owner of a patent on a machine or
bination comprised of unpatented elements is given the right
nopolize sale of an element thereof which has a substantially
ter life cycle than the machine's other components and must
replaced in order to preserve the continued utility of the
chased machine."

[4] References to "Tr." are to testimony taken during the trial,
unprinted.

admitted, however, and both Courts below found (J.A. 39, 213; Pet. 32) that a quite different and clearly non-infringing fabric shape could be installed on the car without impairing the utility of the car. The District Court specifically found (JA 39, footnote 8) that—

> "If an owner does not want to replace with plaintiffs top, *he does not have to.* Defendants admitted it is even cheaper, and as an easier installation, to replace with the outside-snap type than with a new Mackie-Duluk." [Italics added.]

The Government's factual premise is, therefore, incorrect.

The Government's restated question also states, incorrectly, that frequent replacement of the fabric is necessary "to preserve the continued utility" of the automobile. This error is repeated at U.S. Memo. 7, where the Government states that replacement is necessary if the machine "is to remain operative". However, as has been shown, utility could be continued with an entirely differently shaped fabric. Moreover, replacement is not made for utility reasons in most cases, but, as the District Court found (JA 41) "because of convertible owners' interest in appearance." Indeed, the District Court found (JA 33) that "from the standpoint of utility a top might last many years * * *." The Court of Appeals also found that a top has utility for a time "much longer" than three years (Pet. 32). In other words, continued utility, and attractiveness, are entirely distinct insofar as life of the top fabric is concerned.

The Government's Memorandum (twice at p. 7) also states, incorrectly, that when replacement is made, the top is "worn-out". This error is repeated at U.S.

Memo. 4 (the fabric becomes "unusable"), and at U.S. Memo. 9 ("replacement of the worn-out fabric"). But, at the time of replacement, the fabric is ordinarily *not* "worn-out". Petitioners themselves admitted that replacement is often made when the top is "in perfectly good condition" (JA 98); and the District Court specifically found that, at replacement, the top usually has only "superficial wear" (JA 34) rather than being worn out.

The Government's Memorandum (p. 7) further incorrectly assumes that replacement represents "restoration of the machine to the original use". However, this case is not one in which, as in *Wilson* v. *Simpson*, 9 How. 109, the machine was "so arranged" by the inventor that replacement of the fabric has to be made in a particular way corresponding to the original structure; nor, is replacement effected "to identify the machine with what it was at the beginning of its use"; nor is replacement with the same top, and in the same manner as the original structure, "the only way in which the machine can be used." (All of the foregoing quotations are from this Court's opinion in *Wilson* v. *Simpson*.)

Indeed, here the facts are quite otherwise. Petitioners themselves argued at p. 11 of their Court of Appeals brief:

> "Replacement techniques and styling of the replacement top vary from that practiced by the original automobile manufacturer, often resulting in a replacement top appearing, and secured in many instances in a different manner from the original installation."

Petitioners made changes in both the styling and structure of the top fabric; and in some instances appar-

ently went so far as to make changes in the automobile body itself. Thus, see the Deposition of H. Shapiro, Oct. 4, 1956, p. 24 (unprinted):

> "* * * We made a top for the 1952 [Ford] car, which was *completely redesigned* in 1953; that is, the seam structure. Actually, the size has to be the same because it is going on the same frame, but the seam structure and the structure of the rear valance and the rear curtain *has been changed*, and we *did away* with the cushion and came out with the shingle, and *then we did away* with the shingle. In other words, *we probably had five patterns made of that particular model car, 134.*" [Italics added.]

And see (JA 125-6):

> "We made a top—*we made* [*it*] *completely different as far as looks were concerned*, with the 1952 Ford, because they had a very, very tremendous wrap-around curtain that was probably twice the size of what is on the car now * * *." [Italics added.]

And see (JA 475):

> "In installing this [Aro replacement] top in automobiles having elements similar to those shown in Figure 2 of the Mackie patent, the rubber molding elements 27 [on the car] *are first removed* in order order to make room for the flap member."

Indeed, in some cases, the "replaced" top infringed different claims of the Mackie-Duluk patent than had been infringed by the original structure. These many changes made by petitioners, while always involving the unique Mackie-Duluk fabric shape, went far beyond mere restoration to operativeness, and constituted clear reconstruction rather than merely repair of the combination.

In short, the instant case can hardly provide a vehicle for determination of the restated question presented by the Government; for the facts of record are at such variance with those assumed in the question, that the Government's question can never be reached.

The Government has suggested no workable test to be substituted for that previously laid down by this Court in *Wilson* v. *Simpson*, 9 How. 109, and in *Heyer* v. *Duplicator Mfg. Co.*, 263 U.S. 100. Insofar as the Government's presently proposed restatement (U.S. Memo. 10), that "reconstruction of a patented machine or combination comprised of unpatented components is to be limited to true reconstruction of the machine, that is, re-creating it after the machine, viewed as a whole, has been destroyed or has otherwise disintegrated," can be understood, it is clear that it would lead to absurd results. For example, a wooden house of completely new structure, supported on an entirely conventional stone foundation (wood having a normal and anticipated life shorter than stone), could be razed to the foundation and thereafter completely rebuilt, even with significant alterations; and under the suggested test this would represent no more than a "repair" of the house.

The possible situations which might arise are, indeed, as varied as the different combinations of structures (or different materials having different wearing properties) which might be fabricated. The almost infinite factual distinctions which could appear for consideration emphasize that the only rational way of approaching the problem is precisely the way sanctioned by this Court, and adopted by the courts below, i.e. the application of common sense to the specific facts, with each case being limited to its own facts pretty much as an individual instance (Pet. 31).

IV. THE DECISION BELOW IS NOT IN CONFLICT WITH ANY RULINGS OF THIS COURT

In each of the "extension of monopoly" and "tie-in" cases cited (U.S. Memo, 3, 6-7) by the Government (*Motion Picture Patents Co.* v. *Universal Film Co.*, 243 U.S. 502; *Carbice Corp.* v. *American Patents Corp.*, 283 U.S. 27; *Mercoid Corp.* v. *Mid-Continent Corp.*, 320 U.S. 661; *Leitch Mfg. Co.* v. *Barber Co.*, 302 U.S. 458; *Morton Salt Co.* v. *G. S. Suppiger Co.*, 314 U.S. 488; *B.B. Chemical Co.* v. *Ellis*, 314 U.S. 495), the patentee was actually manufacturing and/or selling unpatented articles and sought to eliminate his competition through use of a patent. This is not the case here. *Respondent does not manufacture or sell anything.* This Court has itself recognized the factual distinction thus presented; see *Automatic Radio* v. *Hazeltine Research*, 339 U.S. 827, 831.

Respondent's only affirmative action in this entire matter has been to seek enforcement of its patent rights against a defendant who has stubbornly refused a license, a defendant who has not only violated the contributory infringement provisions of 35 U.S.C. § 271 (c), but who has also violated the direct infringement provisions of 35 U.S.C. § 271(a). Such legal action by a patentee, having no other recourse, was never condemned in any of the decisions cited, just mentioned; and indeed 35 U.S.C. § 271(d)(3) [Pet. 19] expressly states that such legal action against a direct and contributory infringer does *not* constitute an "illegal extension of the patent right." Again, therefore, the principles of the cases cited by the Government, and their proper application, is not in dispute; and the sole distinction is factual.

CONCLUSION

For the foregoing additional reasons, it is respectfully submitted that this petition for a writ of certiorari should be denied.

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APPENDIX 1

Testimony of H. Shapiro, September 22, 1959, and November 13, 1959.

Accounting Transcript 186:

"Q. [Mr. Pollock] I understand that you have recently stopped making tops of the Mackie-Duluk shape. Is that correct?

A. [H. Shapiro] That is correct.

Q. When did this top manufacture cease?

A. It has ceased within the period of Judge Aldrich's decision, where he did not grant us a rehearing. The Court of Appeals did not grant us a rehearing of the case.

Q. Was it a week ago or so?

A. Approximately a week ago.

Q. Approximately a week ago. Up until that time you were manufacturing and selling tops with the Mackie-Duluk shape? Is that correct?

A. That is correct.

Q. What is the new shape you are using?

A. Snap fasteners on the outside.

Q. Do you have any idea how these are selling?

A. I checked the first day that we shipped a few of them out and there has not been any repercussions. In fact, we had one or two of our accounts that commented on them and claimed that they could do an easier installation because they did not have to crawl inside the car."

Accounting Transcript 187:

"Q. Now, was the change made to the Part 232?

A. Yes.

Q. You changed your No. 232 completely, then, to the snap fastener as well?

A. That is correct.

Q. The other parts that are listed in the Court's Interlocutory Decree, have they been changed as well?

A. Yes, they have.

Accounting Transcript 516:

"Q. [Mr. Wolf] Is this a top for the new style?

A. [H. Shapiro] The only difference between this and the other label are initials "NS" printed on the label or adjacent to the label on our boxes.

Q. This is to identify—

A. New Style, meaning outside installations.

Q. Do you use this on all the types you are now selling, that very same numerical number that was considered infringing?

A. Yes, every top going out is marked with that and the construction of the top is changed.

Mr. Wolf. I offer that.

The Witness. In fact, our new catalog shows—it will be ready in a week or two—we note as preceding the number an asterisk, and down at the bottom is marked 'New Style, outside installation.'

Q. Have you had any degree of success in selling these tops?

A. Yes, we have had quite a bit of success. In fact, we have some men that call and want to know if we can make all our late model tops with that so that the man does not have to crawl inside the car to do the installation, he can work completely outside."

APPENDIX 2

Court of Appeals, Brief for Defendants, Appellants (Petitioners Herein) pp. 23-25

Replacing Worn Fabric Tops Is a Permissible Repair Under the "Common Sense" Doctrine Established by the Supreme Court and Followed in This Circuit.

A number of cases have considered the problem of what constitutes permissible repair as compared with a non-permissible reconstruction of the patented combination. In many instances it is rather difficult to draw a line between permissible repair and unpermissible reconstruction. In considering these cases, courts have evolved several tests in attempting to properly classify acts as being permissible or not. The dominant view which is followed in this particular circuit was established by the Supreme Court in *Heyer* v. *Duplicating Mfg. Co.*, *supra* at 17, where the court applied what might be termed "a common sense" doctrine. In that case the court said:

> We have only to establish the construction of a bargain on principles of common sense applied to the specific facts . . . 263 U.S. at 102.

This doctrine has been carefully followed by this court where it stated in the leading case of *Goodyear Shoe Mach. Co.*, v. *Jackson*, *supra* at 18:

> A purchaser, then, may repair, but not reconstruct or reproduce, the patented device or machine. Repair is "restoration to a sound, good, or complete state after decay, injury, dilapidation, or partial destruction." Reconstruction is "the act of constructing again." Reproduction is "repetition," or "the act of reproducing."

* * *

These definitions are instructive in bringing home to the mind that repair carries with it the idea of restoration after decay, injury, or partial destruction, and that reconstruction or reproduction carries with it the idea of complete construction or reproduction over again.

But the difficult question still remains, what is legitimate repair, and what is reconstruction or reproduction as applied to a particular patented device or machine? When does repair destroy the identity of such a device or machine and encroach upon invention? At what point does legitimate repair of such device or machine end, and where does illegitimate reconstruction begin?

It is impracticable, as well as unwise, to attempt to lay down any rule on this subject owing to the number and infinite variety of patented inventions. *Each case, as it arises must be decided in the light of all the facts and circumstances presented, and with an intelligent comprehension of the scope, nature, and purpose of the patented invention, and the fair and reasonable intention of the parties. Having clearly in mind the specification and claims of the patent, together with the condition of decay or destruction of the patented device or machine, the question whether its restoration to a sound state was legitimate repair, or substantial reconstruction or reproduction of the patented invention, should be determined less by definitions or technical rules than by the exercise of sound common sense and an intelligent judgment.* (Emphasis added) 112 Fed. at 150.

While courts of other circuits have also discussed what constitutes the dominant element of the invention, most still apparently apply the rationale of the "common sense" doctrine. See *Landis Machine Co.* v. *Chaso Tool*

Co., 141 F.2d 800 (6th Cir.), *cert. denied*, 323 U.S. [illegible] (1944).

It is not clear what doctrine the district court applied in concluding that replacing worn fabric tops constituted reconstruction of the patented combination rather than permissible repair. Regardless of what doctrine is applied, its conclusion is unsound. The application of the "common sense" doctrine requires a review of (a) what Mackie and Duluk *claimed* as their invention in the light of the relevant prior art, (b) the normal expectation of vendors of convertible automobiles, (c) the normal expectation of purchasers of convertible automobiles, (d) the rewards already received by the plaintiff's assignor, (e) the fact that the fabric tops are frequently replaced, (f) the custom of the replacement trade in replacing the tops and, (g) that the fabric top itself is old and unpatentable.